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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,458	12/29/2003	Michael A. Rothman	42P18118	7059

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Anthony H. Azure  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
Seventh Floor  
12400 Wilshire Boulevard  
Los Angeles, CA 90025

EXAMINER

ELAMIN, ABDELMONIEM I

ART UNIT	PAPER NUMBER
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2116

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,458	<b>Applicant(s)</b> ROTHMAN ET AL.	
	<b>Examiner</b> A Elamin	<b>Art Unit</b> 2116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 9-16 are rejected under 35 U.S.C. 101 because the claims are non-statutory as not being **tangibly embodied** in a manner so as to be executable. In the specification, pages 13 and 14, the alleged computer readable medium is not limited to tangible product or medium.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 8-10, 13-14, 17-18, 21, 23, are rejected under 35 U.S.C. 102(e) as being anticipated by Joseph et al, US. Pat. No. 6,993,645.

5. Claims 1, 9, 13, 23, Joseph teaches a method [*see Figs. 3-4*], comprising:

accessing a pre-boot driver at a computer system during operating system runtime of the computer system [*Fig. 4, col. 6, lines 1-17, 60-62*];

depositing the pre-boot driver in a repository available to firmware of the computer system [*disk-storage utility 56 of Fig. 2*];

finding the pre-boot driver at the repository by the firmware during a subsequent pre-boot phase of the computer system [*see step 46 of Fig. 3, col. 4, lines 66-67*]; and

executing the pre-boot driver during the subsequent pre-boot phase [*step 48 of Fig. 3*].

6. Claims 2, Joseph teaches executing the pre-boot driver includes launching a pre-boot driver interpreter to execute the pre-boot driver [*content player 32 of Fig. 2*].

7. Claims 3, 10, 14, 21, Joseph teaches the repository comprises a non-volatile storage device [*disk-storage utility 56 of Fig. 2*].

8. Claims 4, Joseph teaches the repository comprises a memory device of the computer system [*see Fig. 2*].

9. Claims 5, 17, Joseph teaches setting a pointer to indicate to the firmware that the pre-boot driver is at the repository [*col. 7, lines 1-9*].

10. Claims 8, Joseph teaches accessing the pre-boot driver comprises downloading the pre-boot driver from a network communicatively coupled to the computer system [*col. 6, lines 1-17*].

11. Claim 18, Joseph teaches the at least one storage device comprises a flash device including firmware instructions and a hard disk including operating system instructions [*col. 3, lines 48-52*].

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 6-7, 11-12, 15-16, 19-20, 22, 24-26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al, US. Pat. No. 6,993,645.

14. Claims 6-7, 11-12, 15-16, 19-20, 22, 24-26, Joseph fails to teach a data structure compatible with firmware that operates in accordance with an Extensible Firmware Interface (EFI) framework standard.

Official notice is taken that both the concept and the advantages of Extensible Firmware Interface (EFI) framework standard are old and well known in the art. The EFI specification defines a new model for the interface between operating systems and platform firmware. The interface consists of data tables that contain platform-related information, plus boot and runtime service calls that are available to the operating system and its loader.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joseph to include a data structure compatible with firmware that operates in accordance with an Extensible Firmware Interface (EFI) framework standard, because it provides a standard environment for booting an operating system and running pre-boot applications [*see*, <http://developer.intel.com/technology/efi/>].

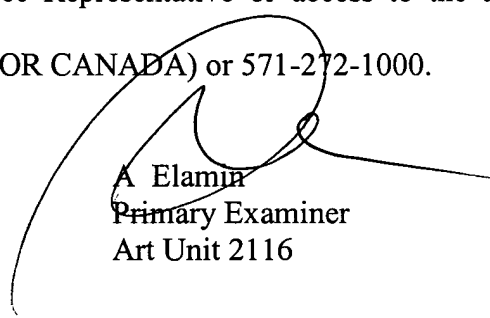
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A Elamin whose telephone number is (571) 272-3674. The examiner can normally be reached on MON-FRI 9:30 AM - 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (571) 272-3670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



A. Elamin  
Primary Examiner  
Art Unit 2116

June 15, 2006